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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,773	12/31/1998	GREGORY S. LINDHORST	3797.09761	3335

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EXAMINER
QUELER, ADAM M

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/223,773	LINDHORST ET AL.
	Examiner	**Art Unit**
	Adam M Queler	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2003* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

　　4a) Of the above claim(s) *17-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: Amendment C filed on 5/19/2003.

2.   Claims 1-20 are pending in the case. Claims 1, 8, and 17 are independent claims.

3.   Claims 1-16 remain rejected over the prior art. Claims 17-20 have been withdrawn.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   **Claims 1-16** remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The converter reconverting the serial execution code into a second event-driven program is not disclosed in the specification. In the interview on 4/2/2002, Applicant's Attorney discussed an example in the specification that allegedly covered the claimed subject matter, on page 24, ll. 17-22. It is the position of the Office that both codes still represent event-driven code. Both code portions are dependent on and event being fired, "onclick." Applicant discloses a similar example on page 26, ll. 4-8. In this case as well while the code has changed shifted from an event-driven paradigm to that of a HTML attribute, the specification would not enable a person of ordinary skill in the art to convert event-drive programs into serial execution code, and in addition does not teach one how to reconvert the code back.

The dependent claims are rejected for fully incorporating the deficiencies of the base claim.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   **Claims 1-16** remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to deficiencies in the disclosure it is not apparent how this claimed subject matter is possible.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   **Claims 1-4, 6-11, 13-14 remain rejected under 35 U.S.C. 102(b) as being anticipated by Ingham (D.B. Ingham, "W3Objects: A Distributed Object-Oriented Web Server", Sixth International World-Wide Web Conference, Santa Clara, California, April 1997).** (Note: The publication date for this paper is provided in the Web page with address *http://w3objects.ncl.ac.uk/pubs*.)

Regarding independent Claim 1 and independent Claim 8, Ingham teaches a distributed object-oriented web server environment known as *W3Objects*. It is stated on page 1, first paragraph that any implementation of *W3Objects*, "conform to an HTTP interface". Therefore, this clearly includes an input for receiving input from Web designers. On page 2, last bullet, it is stated that *W3Objects* persist across requests, and that session-based state can be held internally. This immediately implies that *W3Objects* operate on an event-driven basis.

On page 3, first paragraph, Ingham teaches the language known as *W3Oscript*, which encodes "the presentation logic of a service in an interpreted language". Furthermore, on page 2, first bullet, it is stated, "The architecture supports arbitrary allocation of services to processes and processes to machines, in a manner which is completely transparent to users". Hence, the *W3Objects* is able to translate back-and forth between event-driven programs and serial execution code.

Regarding dependent Claim 2 and dependent Claim 9, Ingham states on page 1, last paragraph, that in the *W3Objects* environment, data passes between the client and the server. This implies that a client is connected to the server. It is already been stated that the *W3Objects* environment is capable of sending and receiving serial execution code. On page 2, first bullet, it is stated, "The architecture supports arbitrary allocation of services to processes and processes to machines, in a manner which is completely transparent to users". This means that from the viewpoint of the server and client, the programs are operating as if they were on a single machine.

Regarding dependent Claim 3 and dependent Claim 10, Ingham states on page 1, first paragraph, that Web resources are represented as objects.

Regarding dependent Claim 4 and dependent Claim 11, Ingham teaches a server-side scripting language called *W3OScript* on page 3, first paragraph. Resulting scripts can themselves be objects, so they can be placed into event-driven programs. Since scripts can be stored as objects, this implies the existence of a scripting library.

Regarding dependent Claims 6, 7, 13, and 14, the object-oriented environment of *W3Objects*

clearly processes event-driven programs. In this environment, it is irrelevant as to whether or not

first and second event-driven programs are the same or different.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.   **Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Ingham.

Regarding dependent claims 15-16, Official Notice is taken that HTML was a well-known

markup language, and would have been obvious to one of ordinary skill in the art at the time of

the invention to include support for it.

12.   **Claims 5 and 12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over**

Ingham (D.B. Ingham, "W3Objects: A Distributed Object-Oriented Web Server", Sixth

International World-Wide Web Conference, Santa Clara, California, April 1997), in view

of *Business Wire* **("Next Microsoft 2: NeXT Software and Microsoft Corp. Q&A",**

Business Wire, **March 1996).** (Note: The publication date for the Ingham paper is provided in

the Web page with address *http://w3objects.ncl.ac.uk/pubs*.)

Regarding dependent Claim 5 and dependent Claim 12, Ingham does not explicitly mention

design-time controls for controlling the generation of objects. However, *Business Wire* teaches

properties of *WebObjects*. *WebObjects* was well-known to be an event-driven, object-oriented

Web environment. On page 1, it is stated that *WebObjects* can generate pages containing applets

such as *ActiveX Controls*. It was well-known that *ActiveX Controls* is a type of design-type

control. One of the major motivations for introducing objects into the Web was to make the use

of dynamic scripting appear to be seamless and user-friendly to the users. For this reason, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the teachings of Ingham and *Business Wire*.

Response to Arguments

13.   Applicant's arguments filed on 10/3/2002 have been fully considered but they are not

persuasive.

Regarding the 112, 1st paragraph rejections: In response to the Applicant's comments, the Office

did not mean to imply that the use of the word "interpret," nor the current use of "convert" is the

issue at hand. As stated in the previous Office Action and repeated above, the main issue is that

converting, interpreting, or otherwise transforming event drive code to serial execution code and

back to event driven code is not disclosed in the specification, nor does it appear to be possible.

The rationale in the previous action is repeated below:

In the interview on 4/2/2002, Applicant's Attorney discussed an example in the specification that

allegedly covered the claimed subject matter, on page 24, ll. 17-22. Regardless of the

amendment that the serial code "includes a markup language," it is the position of the Office that

both codes still represent event-driven code. Both code portions are dependent on and event

being fired, "onclick." Applicant discloses a similar example on page 26, ll. 4-8. In this case as

well while the code has changed shifted from an event-driven paradigm to a HTML attribute, the

specification would not enable a person of ordinary skill in the art to convert event-drive

programs into serial execution code, and in addition does not teach one how to reconvert the

code back.

Due to the claims not being fully disclosed the examiner is not able to determine that the

arguments overcome the previous rejections. For example on page 4 (bottom) through page 5

(middle), applicant argues why Ingham fails to disclose a conversion between serial execution

code and event-driven programs. Due the claims being indefinite and not enabling,

interpretation of the claim language is difficult and the Examiner is unable to determine that the

applicant's arguments overcome the previous rejections.

Conclusion

14.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
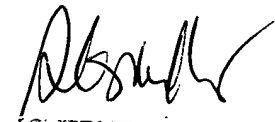
date of this final action.

15.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213.

The examiner can normally be reached on Monday-Friday.

       If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for

the organization where this application or proceeding is assigned are (703) 872-9306 for regular

communications and (703) 872-9306 for After Final communications.

       Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 306-5631.

AQ
January 11, 2004